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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,957	04/02/2004	Naoyuki Kawanishi	Q80132	8928

23373 7590 09/08/2005

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EXAMINER	
CHEA, THORL	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/815,957	KAWANISHI ET AL.	
	Examiner	Art Unit	
	Thorl Chea	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *23-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *23-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/893,750.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claims 23-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23, 27 and 36 is unclear with respect to the intend of claiming step (a) which is related to the formation of silver salt of an organic acid which has been previously prepared before the production of a thermally processed image recording material. Therefore, the scope of protection sought of the processing step in step (a) is unclear whether it was intended to claim the step (a) of formining a silver salt of an organic acid as part of the process of forming a thermally processed image forming material or as an intermediate step for producing a silver salt of an organic acid for the production of a thermally processed image recording material. Claims 36 is unclear with respect to the relationship between step (a) and (b) as to whether the grains of the silver salt of an organic acid is produced in step (a) or otherwise.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 23-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed fail to provide support of the step (a) in claims 23, 27 as part of the processing step of producing a thermally producing a thermally processing image. The specification also fails to describe the use of step (a) in claim 36 as part of the processing steps for producing a thermally processed image recording material.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 23-42 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yasuda (US Patent No. 6,783,925).

See process disclosed in Examples in columns 58-82, especially the process for forming a silver salt of a fatty acid and in Example 1, Table 61 in columns 61-62, and the process for providing

the an image forming layer on a support in column 66, lines 50-69; the process using ultra-filtration and in column 10, and high pressure dispersion apparatus in the abstract, and column 6, lines 35-48. The processing step(a) presented in claims 23, 27, 36 is considered as an intermediate processing step for forming silver salt of an organic acid for used in the process of producing a thermally processed image recording material, and fails to differentiate the process the claimed process from that disclosed in the applied prior art of record. In the absence of providing a convincing evidence showing that difference between the silver salt of an organic acid or thermally processed image recording material and that disclosed in the applied prior art of record, the Examiner asserts that the invention as claimed is either anticipated by or would have been found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

8. Claims 23-42 rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 1069468 (EP'468).

See the process for fabricating the photothermographic material on page 18, [0133],, and the method for forming the silver salt of an organic acid using a closed mixing mean on pages 20-21. See also the document as a whole. The processing step(a) presented in claims 23, 27, 36 is considered as an intermediate processing step for forming silver salt of an organic acid for used in the process of producing a thermally processed image recording material, and fails to differentiate the process the claimed process from that disclosed in the applied prior art of record. In the absence of providing a convincing evidence showing that difference between the silver salt of an organic acid or thermally processed image recording material and that disclosed in the applied prior art of record, the Examiner asserts that the invention as claimed is either anticipated

by or would have been found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made.

9. Claims 23-42 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP'1063566 (EP'566).

See the process for fabricating a heat-developable material on page 28, [0226] to [0227] which comprises the step of providing a image forming layer containing silver salt of an organic salt, a reducing agent and binder on a support to fabricate a heat developable material. The EP'566 may not disclose process for forming silver salt of an organic acid in a sealed mixing means claimed in the present claimed invention. However, the step (a) presented in the claimed invention is directed to the process of forming a silver salt of an organic acid, which is separate process from that of the process of forming a material. Therefore, the invention as claimed is related to claiming a process of a forming a thermally processed image recording material by a process of forming a silver salt of an organic acid. However, the process for providing an imaging layer on a support are the same as taught in the prior art of record. In the absence of showing the criticality of the process of forming the silver salt of an organic acid in the process of forming the a thermally processed image recording material, it is asserted that the invention as claimed is either anticipated or found prima facie obvious over the prior art of record.

10. Claims 23-42 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0962812 (EP'812).

See the process for fabricating a heat-developable material on page 32, [0252] to [0253] which comprises the step of providing a image forming layer containing silver salt of an organic salt, a reducing agent and binder on a support to fabricate a heat developable material. See the

document as a whole. The EP'812 may not disclose process for forming silver salt of an organic acid in a sealed mixing means claimed in the present claimed invention. However, the step (a) presented in the claimed invention is directed to the process of forming a silver salt of an organic acid, which is separate process from that of the process of forming a material. Therefore, the invention as claimed is related to claiming a process of a forming a thermally processed image recording material by a process of forming a silver salt of an organic acid. However, the process for providing an imaging layer on a support are the same as taught in the prior art of record. In the absence of showing the criticality of the process of forming the silver salt of an organic acid in the process of forming the a thermally processed image recording material, it is asserter that the invention as claimed is either anticipated or found prima facie obvious over the prior art of record.

Response to Arguments

11. Applicant's arguments filed June 15, 2005 have been fully considered but they are not persuasive for the reason set forth in the rejection above.

The applicants argued that the step of preparing grains of silver salt is supported by the original claim 9 which discloses a method a method for producing a thermally processed image recording material, including a step of applying a coating solution for an image-forming layer containing an aqueous dispersion of grains of silver salt of an organic acid prepared by the preparation method of claim 1.

It is the Examiner's position that the argument is not persuasive. The language "grains of silver salt of an organic acid prepared by the claimed 1" means that the grains was prepared by using the process of claim 1 for used in the producing thermally processed image recording material.

The step of "preparing" or "reacting" in claim 23, 27, 36 is an active steps which occurs during the production of thermally processed image recording material. It have been recognized in the art that the preparation of the silver salt of an organic acid and the process for producing a thermally processed image recording material should be performed independently.

The applicants'argument with respect to the applied prior art is not persuasive. The applicants argument is related to the process for forming the silver salt of an organic acid, especially step (a) in claims 23, 27, 36. The invention in step (a) presented in claims 23, 27, 36 is considered as an intermediate processing step for forming silver salt of an organic acid for used in the process of producing a thermally processed image recording material, and fails to differentiate the process the claimed process from that disclosed in the applied prior art of record. In the absence of providing a convincing evidence showing that difference between the silver salt of an organic acid or thermally processed image recording material and that disclosed in the applied prior art of record, the Examiner asserts that the invention as claimed is either anticipated by or would have been found prima facie obvious to the worker of ordinary skill in the art at the time the invention was made. The worker of ordinary skill in the art at the time the invention was made to use any known process and formed a thermally processed image recording material by coating a coating composition having grains of silver salt of an organic acid taught in the applied prior art of record. The applicants is referred to a material claimed by a process that fails to differentiate the claimed material of the applied prior art of record, "(E)ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same or obvious from a product of prior art,

the claim is unpatentable even though the prior art product was made by different process." In re Thorpe 777 F.2d 695, 698, 227 USPQ 694, 966 (Fed. Cir. 1985). In this instant claimed invention, the steps of applying a coating solution containing the grains of silver salt of an organic acid prepared in step(a), a reducing agent for silver ions and binder to form an image-forming layer on at least one surface of a support is the step of producing the thermally processed image recording material. The step (a) is an intermediate step which fails to differentiate the process of producing a thermally processed image recording material taught in the applied prior art of record. The rejection over EP'566 is maintained since the English Translation of Japanese Patent Application No. 236044/2000 filed August 3, 2000 fails to provide support for the invention claimed in claims 23-35, and moreover, it fails to support a process for producing a thermally processed image recording material using step (a) and (b) as in combination.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea
September 1, 2005

Thorl Chea
Primary Examiner
Art Unit 1752